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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,732	09/22/2003	Sang Chul Kang	JP920020142US1	9679
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HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER LE, KHANH H	
			ART UNIT 3688	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,732	<b>Applicant(s)</b> KANG ET AL.	
	<b>Examiner</b> KHANH H. LE	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment and Request for Reconsideration filed 11/26/2008 (herein the Response) which has been entered. Claims 1-4, 7-8 were and remain pending. Claims 1, 2 and 7 are amended. Claims 1 and 2 are independent. The amended specification, filed 11/26/2008, correcting the priority document, as requested by the Examiner, is noted and has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**3. Withdrawal of previous rejections under this section (made in the Office Action mailed 10/17/2008), following proper correction:**

Claims 1 and 2: rejection based on “*at the end of the claim, “for the same URL” is confusing*” is withdrawn.

Rejection of Claim 7 based on improper dependence is withdrawn: proper dependence on claim 1 is now claimed.

**4. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

a) Claims 1 and 2: “obtaining at a user computer” is confusing since “a user” is already claimed in the preamble, i.e. are two different users involved? Please correct to “obtaining at the user’s computer” (emphasis on the possessive form) ;

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**Note: Applicant's argument is not persuasive** because “a” in “ a user computer” may be read as modifying “user “, thus the claim is still indefinite.

b) Also “displaying.. in accordance with the advertisement information” is confusing since the “advertisement information” is made up of at least 3 data: the address of the ad on an ad server , effective display period and display location information, so it is not clear what exactly controls the displaying.

**Note: Applicant's argument is not persuasive** because the address of the ad on the ad server has already been used in the reading step which occurs before the displaying step thus, at most, only 2 data (effective display period and display location information), not all 3, are used in the displaying step. Thus reciting “ the advertisement information” which includes all 3 data is confusing. The rejection may be overcome by amending to “displaying.. in accordance with the rest of the advertisement information”.

**Claims 3-4, 7-8 are rejected as being dependent upon rejected base claims 1 or 2. Appropriate correction is required.**

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle US 6,141,010 A in view of Official Notice.**

**6a. Independent claim 1:**

**Hoyle discloses:**

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining at a user computer (*by storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) from a first server (which can be called an ad control server) (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item “associated links”, e.g. ww.lotus.com and associated text);

and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g. “destination links” , “categories”), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 24-37 ; or col. 16 lines 37-44);

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text; col. 16 lines 37-44)

detecting (*by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13*) an URL that the user enters on a web browser (e.g. col. 15 lines 54-59 ; col.16 lines 24-37: ‘recognizing the website being accessed’ );

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retrieving (*by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13*) from the local storage the advertisement information associated with the detected URL (e.g. col. 16 lines 41-44);

reading from the advertisement server (Figure 3 item 22: ADM server 22; col.16 lines 37-44 ) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 41-44), and providing the associated advertisement data from the advertisement server to the user computer over the Internet (col. 16 lines 37-44) ;

and displaying (*by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13*) the associated advertisement data in accordance with the advertisement information (col. 16 lines 37-44).

As to the ad information including information on an effective display period of time , this was previously discussed with respect to now cancelled claims 5 and 13 (see Office Action of 05/30/2008 at page 8).

As discussed earlier, Hoyle does not specifically disclose such (even though HOYLE discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6).

However Official Notice is taken that an “effective display period of time” is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to replace Hoyle’s number of times of display for an ad with an “effective display period of time” for the same ad, so to limit the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

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**6b. ( NOTE: Response to arguments as to the above Official Notice:**

It is acknowledged claim 1 reads in part:

*"...obtaining, at a user computer...information on an effective display period of time... of the advertisement..., and..., deciding a validity of the advertisement to be displayed by determining if the effective display period of time for the advertisement to be displayed has expired, wherein different advertisements can be displayed, each advertisement having a different effective display period of time, for the same URL." (Emphasis added).*

Applicant essentially argues, in giving the Valentine's Day example (Response p. 9-10), that an effective display period of time means a specific period such as early February (Response p. 10). However, "effective display period of time" is not specifically defined in the specification.

Note on interpretation of claim terms: Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so with reasonable clarity, deliberateness, and precision" (MPEP 2111.01 IV). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ... ". See also MPEP 2173.05(a).

The instant application contains no such clear definition for the term "effective display period of time". The term was used only in original claims 1, 2, 5, 6, 13 and 14 without further explanation. The only other relevant part of the specification is paragraph [0032] of the Publication Version of the Application, PG PUB DOCUMENT US 20040059632, which states:

*"Referring to FIG. 4, there is shown a table structure of an*

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*advertisement control information database in accordance with one embodiment of the present invention. The advertisement control information database has information on the control information for each advertisement, such as "display start date", "display end date", "advertisement display time," "advertisement display position," or "advertisement address." The information in the "display start date" and the "display end date" is used to decide the validity of the advertisement display. If the current date is not between the display start date and the display end date, the corresponding advertisement is decided to be invalid and, accordingly, it will not be displayed. The information of the "advertisement display time" is a time period during which the advertisement is displayed. By specifying the advertisement display time, different kinds of advertisements can be displayed on a time basis for the same URL and/or the search word." (emphasis added).*

However "display end date" and like time terms only amount to examples of "effective display period of time " and do not pass the tests of a specific definition as cited above. Thus, in the instant case, the examiner is required to give the term "effective display period of time " its broadest reasonable interpretation, which the examiner judges, can be a maximum total time of display for an ad.

Hoyle discloses a maximum counts of display for an ad (e.g. col.15 lines 54-58; col. 12 lines 5-6) ) so that other ads can be displayed (col. 15 lines 58-59). It is either implicit in Hoyle, or a PHOSITA would have found it obvious from Hoyle that each ad has at least a minimum period of display time. Thus Hoyle implicitly discloses, or it would be obvious from Hoyle that a maximum counts for an ad would translate into a maximum total time of display for an ad, this latter being the product of the maximum counts times some (e.g. minimum) display time of the ad. This is what the Examiner tried to explain with the Official Notice.

Official Notice was taken earlier and repeated above that an "effective display period of time" is only a common alternative for a number of times of display, for the same purpose of



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limiting the time of exposure of a particular ad so others can be displayed (as done in Hoyle, col. 15 lines 58-59). This means that Official Notice was taken that an “effective display period of time”, which can be interpreted as a maximum total time of display for an ad, is only a common alternative for a number of times of display. This fact is well-known, at least because it can be inferred logically, at least from the above cited Hoyle teachings, as explained above.

The same response applies to claim 2 below which has the same limitations as claim 1. )

**6c. Next as to the display location information of the advertisement, Hoyle does not specifically disclose such.** However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle’s ad data, display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

As to deciding the validity of the advertisement to be displayed by determining if the effective display period of time for the advertisement to be displayed has expired , this was discussed earlier with respect to now cancelled claims 6 and 14 (see Office Action of 05/30/2008 at page 8), Hoyle, col. 12 lines 5-6, discloses an allotted number of times to display each ad, and mentions a timer, thus this reads on “determining if the effective display period of time for the advertisement to be displayed has expired” thereby also reading on ” deciding the validity of the advertisement to be displayed”.

As to “wherein different advertisements can be displayed, each advertisement having a different effective display period of time, for the same URL”, this is a statement of effect. In the system of Hoyle, modified as above-discussed, since different ads would be displayed per effective time allotted, the effect would be that different ads would be displayed, based on the same URL entered by the user (Hoyle col. 15 lines 54-59).

**7. Independent claim 2:**

Hoyle discloses:

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs and search keywords (Figure 7 item “associated links” and associated text; col.16 lines 1-8) and associated advertisement information for each of the web page URLs and the search keywords (Figure 7 and associated text; e.g. “destination links”, “categories”; col.16 lines 1-8; col.16 lines 24-37), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 37-44);

and storing *(by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13)* said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text; col.16 lines 37-44);

detecting *(by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13)* an URL and a search keyword that the user enters on a web browser (col.16 lines 24-37: ‘recognizing.. the website being accessed,..the keywords used’);

retrieving *(by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13)* from the local storage the advertisement information associated with the detected URL and the search keyword (col.16 lines 24-37; col.16 lines 37-44);

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reading from the advertisement server (Figure 3 item 22: ADM server 22; col.16 lines 37-52 ) the associated advertisement data at the advertisement address included in the retrieved advertisement information (e.g. col.16 lines 37-44);

and displaying (*by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13*) the associated advertisement data in accordance with the advertisement information (e.g. col. 16 line 35).

As to the ad information including information on an effective display period of time , this was previously discussed with respect to now cancelled claims 5 and 13 (see Office Action of 05/30/2008 at page 8).

As discussed earlier, Hoyle does not specifically disclose such (even though HOYLE discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6)).

However Official Notice is taken that an “effective display period of time” is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a PHOSITA to replace Hoyle’s number of times of display for an ad with an “effective display period of time” for the same ad, so to limit the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Also, Hoyle does not specifically disclose display location information of the advertisement. However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle’s ad data display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

As to deciding the validity of the advertisement to be displayed by determining if the effective display period of time for the advertisement to be displayed has expired , this was

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discussed earlier with respect to now cancelled claims 6 and 14 (see Office Action of 05/30/2008 at page 8), Hoyle, col. 12 lines 5-6, discloses an allotted number of times to display each ad, and mentions a timer, thus this reads on “*determining if the effective display period of time for the advertisement to be displayed has expired*” thereby also reading on “deciding the validity of the advertisement to be displayed”.

As to “wherein different advertisements can be displayed, each advertisement having a different effective display period of time, for the same URL”, this is a statement of effect. In the system of Hoyle, modified as above-discussed, since different ads would be displayed per effective time allotted, the effect would be that different ads would be displayed, based on the same URL and search keyword entered by the user (Hoyle col. 15 lines 54-59).

#### **8. Claims 3-4:**

HOYLE modified as discussed above discloses a method and system as in Claims 1-2 above and HOYLE further discloses wherein the web page URLs and the search keywords are represented by regular expressions (Figure 3, e.g. URL is www.sports.com; keyword is sports or stocks).

*(Note: Since the only relevant paragraph [0031] of the published version of the specification-- US 20040143496-- fails to specifically define “regular expressions”, this phrase is interpreted as any expression such as a English terms e.g. “sports”).*

#### **9. Claim 8:**

HOYLE modified as discussed above discloses a method and system as in claim 1 above. Hoyle further discloses the advertisement control server and the advertisement server are the same server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40).

Note: also it is admitted it is within the level of skill in the art to make **the** advertisement control server and the advertisement server are the same server. (See Specification at [0027]).

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**10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle as applied to claim 1 above, and further in view of Nicholas III, US 6,865,719.**

Claim 7:

HOYLE modified as discussed above discloses a method and system as in claim 1 above.

However, Hoyle does not disclose wherein said step of displaying further comprises the step of determining if the advertisement will be displayed within a web browser or outside the web browser, based on the display location information.

However, Nicholas discloses ads shown inside or outside of the browser (Figure 4A items 408 and associated text; col. 7 lines 55 col. 8 line 8). It would have been obvious to a PHOSITA to add this teaching of Nicholas to Hoyle to allow the ad to display where the user 's focus is best (Nicholas, col. 2 lines 53-67).

### **Response to Arguments**

11. Applicant's arguments have been fully considered but they are not persuasive. The arguments pertaining to rejections under *35 USC § 112, 2<sup>nd</sup> paragraph, and 35 USC § 103* (made in the Office Action mailed 10/17/2008) are addressed above in the discussion of each respective statutory section.

### **Conclusion**

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**13.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/

Examiner, Art Unit 3688

February 25, 2009

/Donald L. Champagne/

Primary Examiner, Art Unit 3688